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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/937,647	01/29/2002	Michael Rosenthal	041165/9023	2467

7590 10/12/2004

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EXAMINER

MULCAHY, PETER D

ART UNIT PAPER NUMBER

1713

DATE MAILED: 10/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/937,647

Applicant(s)

ROSENTHAL ET AL.

Examiner

Peter D. Mulcahy

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-23 and 27-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-23 and 27-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit 1713

The rejection as set forth under 35 U.S.C. § 112 is herein withdrawn. Applicants' amendments have obviated this rejection.

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14-23 and 27-31 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ejik, U.S. Patent 4,132,691 taken alone or further in view of Sugahara et al., U.S. Patent 4,060,508.

The rejection as set forth under 35 U.S.C. § 103 in the paper mailed March 22, 2004 is deemed proper and is herein repeated.

Applicants' remarks have been fully considered but have been deemed to be not persuasive.

With respect to the Ejik patent, applicants argue that the zinc oxide and/or zinc hydroxide are less preferred given the undesirable interaction between the zinc and the lubricant composition. Case law has well established that mentioned disadvantages do not properly constitute grounds for

patentability. See In re Boe 148 USPQ 507. The more germane portions of the disclosure are those where the zinc salt is disclosed as being a stabilizer to be utilized in combination with both the tin and calcium compounds. Applicants address this rejection by arguing that the disclosure of Ejkc does not contain any hint that zinc salts can be combined with organotin compounds identified as the heat stabilizers. This is not persuasive. The Examiner maintains that Ejkc does teach the compounds functioning in an advantageous manner when mixed into the vinyl chloride resin compositions. It is prima facie obvious to combine ingredients and have them function in an expected manner. Here, each of the compounds is specifically identified as being desirable and one of ordinary skill in the art would find it prima facie obvious to use them in combination with one another and have them function in an expected manner. The adverse effects of the zinc as mentioned by applicants has no bearing on the obviousness of combining the zinc salt with the tin stabilizer. The Ejkc patent is clear as to the functionality of both the zinc salt and tin compound.

In addressing the combination rejection, applicants argue that the Sugahara patent shows the zinc salts to be the least effective stabilizers when incorporated into the composition. This argument does not render the instantly claimed invention

patentable over the combination of these references. Once again, the mentioned disadvantages of the compound do not negate its obviousness and applicants have failed to show that the instantly claimed composition is any more effective in stabilizing the vinyl halide resin compositions than that of the prior art. The courts have well established that it is prima facie obvious to combine known ingredients and have them function in an expected manner. In re Linder, 173 USPQ 356.

Applicants then identify claims 30 and 31 as being allowable over the prior art for the same reasons as claim 14 is considered allowable and additionally for the recitation of the specific zinc compounds to be selected. The limitations of claims 30 and 31 are not considered to be patentable over the prior art. The zinc salts of saturated aliphatic carboxylic acids having from 10 to 18 carbon atoms are seen to be expressly disclosed within each of the patents where the carboxylic acids are identified. Furthermore the zinc oxide and hydroxide are considered to be rendered prima facie obvious by Ejkc for the reasons as advanced supra.

The limitations of claims 15-23 and 27-29 have not been specifically argued by applicants. The preferred amounts, species or properties as identified in these claims are considered to be either anticipated or rendered prima facie

obvious for the reasons as advanced in the prior Office action.

THIS ACTION IS MADE FINAL. Applicants are reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter D. Mulcahy, whose telephone number is (571) 272-1107. The examiner can normally be reached during regular business hours.

The fax telephone number for this group is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be

Serial No. 09/937,647

-6-

Art Unit 1713

obtained from either private PAIR or public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

P. Mulcahy:cdc
October 8, 2004

A handwritten signature in black ink, appearing to read "P. Mulcahy", with a long, sweeping underline that extends downwards and to the right.

PETER D. MULCAHY
PRIMARY EXAMINER